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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------------|------------------------|
| 10/673,736 | 09/29/2003 | Martin Miller | 455610-2590.1 | 1927 |
| 20999 7590 10/17/2007 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151 | | | EXAMINER CHUNG, PHUNG M | |
| | | | ART UNIT 2117 | PAPER NUMBER |
| | | | MAIL DATE 10/17/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------------------|-------------------------------|--|
| Office Action Summary | Application No. 10/673,736 | Applicant(s) MILLER ET AL. | |
| | Examiner Phung My Chung | Art Unit 2117 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date
:10/18/04, 12/8/04, 8/22/05 and 2/28/06.



PHUNG M. CHUNG
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100

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Election/Restrictions

1. Applicant's election without traverse of Group II, claims 22-26 in the reply filed on 7/19/07 is acknowledged.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 10-12 of copending application No. 10/673,712, claims 9 of copending application No. 10/673,713, and claims 1-21 of copending application No. 10/673,735. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitation of the rejected claims are claimed in at least one of the claims 1-3, 10-12, claim 9 and claims 1-21 of the copending applications, and there is no

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reason why the rejected claims could not have been presented in the copending applications 10/673,712, 10/673,713 and 10/673,735.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following are claims comparison table:

Claims Comparison Table

| | 10/673,736 | 10/673,712 |
|---------|-------------------|-------------------|
| Claims: | 1, 17 | 1, 10 |
| | 2, 21 | 2, 11 |
| | 8-9, 10 | 3, 12 |
| | 10/673,736 | 10/673,713 |
| Claims: | 1, 17 | 9 |
| | 10/673,736 | 10/673,735 |
| Claims: | 1 | 1 |
| | 2 | 2 |
| | 3 | 3 |
| | 4 | 4 |
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| | 7 | 7 |
| | 8 | 8 |
| | 9 | 9 |

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| 21 | 21 |

Claim Rejections - 35 USC § 112

4. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, line 5, "recovering a clock signal from said stored data signal" is not clear why and how recovering the clock signal from the stored data signal.

As per claims 2-16, these claims are also rejected because they dependent upon the rejected base claim.

As per claim 17, line 5, "recovering a clock signal from said stored data signal" is not clear why and how recovering the clock signal from the stored data signal.

As per claims 18-21, these claims are also rejected because they dependent upon the rejected base claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1 and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Tan et al (6,812,688).

As per claim 1, Tan et al disclose a method for displaying an eye diagram, comprising the steps of:

acquiring a data signal by an acquisition unit (120) of a test instrument for a predetermined time;

storing said data signal in a memory of said test instrument (acquisition memory, lines 64-65);

recovering a clock signal from said stored data signal (col. 3, lines 26-30); and

slicing said stored data signal into a plurality of data segments of a predetermined length in accordance with said recovered clock signal by a processor (130). (See Fig. 1, col. 2, lines 56-67 to col. 3, lines 1-2, col. 3, lines 12-25 and col. 1, lines 29-42).

As per claims 17-20, Tan et al disclose a method for displaying an eye diagram, comprising the steps of:

acquiring a data signal by an acquisition unit (120) of a test instrument for a predetermined time;

storing said data signal in a memory of said test instrument (acquisition memory, lines 64-65);

recovering a clock signal from said stored data signal (col. 3, lines 26-30);

slicing said stored data signal into a plurality of data segments of a predetermined length in accordance with said recovered clock signal by a processor (130); and

overlaying said plurality of data segments on a display (130) in a time synchronized manner. (See Fig. 1, col. 2, lines 56-67 to col. 3, lines 1-2, col. 3, lines 12-25 and col. 1, lines 29-42).


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phung My Chung whose telephone number is 571-272-3818. The examiner can normally be reached on Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on 571-272-6962. The fax phone

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· number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Phung My Chung
Primary Patent Examiner
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